



# Bulletin

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## European Parliament: Proposed Nutrition and Health Claims Regulation's Impact on Trademarks

On January 23, 2006, the European Parliament confirmed receipt of the European Council's 2005 Common Position on the proposed nutrition and health claims Regulation. This began the proposal's Second Reading.

Contrary to what Parliament had adopted in May 2005, the Council Common Position reintroduced trademarks to the Regulation's scope.

Common Position Article 1.3 provides:

A trade mark, brand name or fancy name appearing in the labelling, presentation or advertising of a food which may be construed as a nutrition or health claim may be used without undergoing the authorisation procedures provided for in this Regulation, provided that it is accompanied by a related nutrition or health claim in that labelling, presentation or advertising which complies with the provisions of this Regulation.



Article 27.2 further provides:

Products bearing trade marks or brand names existing before 1 January 2005 which do not comply with this Regulation may continue to be marketed until [date of entry into force of the Regulation plus ten years], after which time the provisions of this Regulation shall apply.

Members of the European Parliament (MEPs) first discussed the Council Common Position on January 31, 2006. Several speakers criticized the fact that the Common Position did not incorporate most of Parliament's May 2005 amendments, including an amendment that called for exclusion of trademarks. Several MEPs stressed that the Council's new wording on trademarks was too complicated and that the May 2005 amendment calling for total exclusion of trademarks should be reconsidered. The Commission representative responded to MEPs' comments, stressing that the issue of trademarks was very important and that the

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## Trademark Counsel for New Business Owners: Tips for the New Practitioner

Trademark? Service mark? Copyright? Patent? It's not unusual for new business owners to become confused regarding the best methods for protecting valuable intellectual property. Accordingly, it is important for trademark practitioners to understand the needs of new business owners and to help them answer all questions—even those the business owners have yet to formulate.

Perhaps the best place to start is a general discussion about intellectual property. Begin with the basics; never assume that the new business owner understands the fundamental differences between the types of protection available for intellectual property. Start by briefly defining a trademark or service mark (protection of a word, phrase, symbol or design used in connection with a product or service),

a copyright (protection of the expression of an idea) and a patent (protection of a new and useful invention or design). You will know pretty quickly whether your client needs more in-depth information. While it may be true that the individual sitting across from you is a brilliant businessperson, an ingenious entrepreneur or a pioneering inventor, do not underestimate his or her need for astute legal counsel. By the same token, be prepared to seek assistance from a colleague should the new business owner's needs exceed your area(s) of expertise.

Once the basics have been explained (the time for this will vary for each client), dive into the specific needs of the new business owner. It may be helpful to engage in an anecdotal conversation that relates to the client's industry. For example,

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## Kiev Seminar on Mediation as Alternative Method for Commercial Dispute Resolution

Alternative dispute resolution (ADR) in the Ukraine and Russia was the subject of INTA's November 29, 2005, seminar in Kiev. The 44 participants included personnel from the State Department of Intellectual Property, practicing lawyers and patent and trademark agents, and representatives of governmental bodies such as the Antimonopoly Committee of Ukraine and the Supreme Commercial Court of Ukraine. The business community was also well represented.

Deputy Head of the State Department of Intellectual Property Volodymyr Zharov presented an overview of Ukrainian intellectual property (IP) rights protection and the potential for ADR methods such as mediation in the settlement of IP disputes. Dr. Irina Paliashvili, president of the Ukrainian Legal Group, and Antonina Pakharenko-Anderson of Pakharenko and Partners talked about current regional trends in mediation, including plans to set up a



Toe Su Aung, BATMark Limited, addresses the Kiev seminar. Ms. Aung is 2006-2007 chair of the Anti-Counterfeiting and Enforcement Committee.



Seminar participants develop their mediation strategy

Ukrainian Commercial Mediation Center (UCCM) in Kiev.

Guest speaker Toe Su Aung discussed when mediation is suitable for IP disputes. Ms. Aung is general counsel with BATMark Limited and is the 2006-2007 chair of INTA's Anti-Counterfeiting and Enforcement Committee.

Also addressing the group was Roman Koval, president of the Ukrainian Center for Common Ground and one of the first specialists to introduce mediation in the Ukraine. The Center for Common Ground provides mediator training in the Ukraine. Mr. Koval spoke about criminal, civil and labor cases he and his colleagues have mediated. He also discussed the proposed UCCM.

After watching an INTA mediation film (complete with Russian subtitles), participants discussed principles of mediation, including neutrality and confidentiality. They then divided into three groups to participate in a mock mediation by applying INTA guidelines to Problem Case 1: "The Washington Post Company v. The Washington Post Bar & Grill and Irving Cooper." The parties used mediation procedures such as joint sessions, separate meetings and internal caucuses to negotiate based on their interests rather than their positions. All three groups successfully reached a settlement through mediation.

The event was organized under the auspices of INTA by the law

firms Pakharenko and Partners and Ukrainian Legal Group, L.L.C. (Russian-Ukrainian Legal Group, P.A.), with the active participation of the State Department of Intellectual Property (Ministry of Education and Science of Ukraine). Attendance was free thanks to the generous sponsorship of A/T B.A.T. – Prilucky Tobacco Company.

By Irina Paliashvili, Russian-Ukrainian Legal Group, P.A., Washington, D.C. and Kiev

## Geographical Indications Committee Analyzes WTO Settlement of GI Dispute

In March 2005, the World Trade Organization's (WTO's) Dispute Settlement Body issued a decision regarding the conflict between trademarks and geographical indications (GIs). The dispute had arisen over whether European Council Regulation 2081/92 on GIs and Designations of Origin conflicted with trademark protection obligations of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS). Australia and the United States raised concerns related to the Regulation's treatment of trademark registrations that conflicted with later-registered GIs.

The WTO Panel generally upheld the position of Australia and the United States but held that under certain circumstances exceptions applied to permit coexistence of GIs and prior trademarks.

The 2004-2005 Geographical Indications Committee has prepared a detailed summary of the parties' positions and the panel's findings and offers insight on how the conflict might be further resolved. The Analysis is available at:

[http://www.inta.org/downloads/tap\\_WTOdecision.pdf](http://www.inta.org/downloads/tap_WTOdecision.pdf)